

ESTTA Tracking number: **ESTTA41547**

Filing date: **08/08/2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91125615
Party	Plaintiff UNIVERSITY OF SOUTHERN CALIFORNIA ,
Correspondence Address	SCOTT A. EDELMAN GIBSON DUNN & CRUTCHER, LLP 2029 CENTURY PARK EAST, STE. 4000 LOS ANGELES, CA 90067-3026
Submission	Answer to Counterclaim
Filer's Name	Peter F. Weinberg
Filer's e-mail	ptodenver@gibsondunn.com
Signature	/Peter F. Weinberg/
Date	08/08/2005
Attachments	answer.pdf (4 pages)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

University of Southern California,

Opposer,

v.

University of South Carolina

Applicant.

Opposition No. 91125615

Serial No. 75/358,031

Mark: SC (Stylized)

Filed: September 16, 1997

Published: January 11, 2000

Answer to Counterclaim

Further to the Board Order mailed July 22, 2005, University of Southern California ("California") hereby answers the counterclaim filed by University of South Carolina ("Carolina") on September 15, 2004 against California's registration no. 2,683,137. References to paragraphs herein refer to the correspondingly numbered paragraphs in the counterclaim.

21. California admits the allegations of this paragraph.

22. California admits the allegations of this paragraph.

23. California admits the allegations of this paragraph.

24. California admits only that the "SC" has been and is used as an abbreviation for "South Carolina" in some contexts. California denies that "SC" is a symbol and insignia of the State of South Carolina, and submits that this issue has been settled in this proceeding by the Board's order of July 31, 2003 dismissing Carolina's claims against California based on 15 U.S.C. § 1052(b).

25. California is without knowledge or information sufficient to form a belief as to the truth of the allegations of this paragraph, and denies them on that basis.

26. California is without knowledge or information sufficient to form a belief as to the truth of the allegations of this paragraph and denies them on that basis. By way of amplification, California does not believe that (i) Carolina has used an "SC" mark in any substantial,

commercial manner to acquire common-law rights, and certainly not rights that are superior to California's rights in the "SC" mark, and (ii) Carolina has used an "SC" mark "continuously," as it alleges.

27. California is without knowledge or information sufficient to form a belief as to the truth of the allegations of this paragraph and denies them on that basis.

28. California is without knowledge or information sufficient to form a belief as to the truth of the allegations of this paragraph and denies them on that basis, except that California specifically denies that the SC mark is a famous and distinctive mark of Carolina and that the letters "point uniquely and unmistakably to [Carolina]." Moreover, California owns an incontestable registration for the letters SC (registration no. 1,844,953, which is at issue in this proceeding).

29. California admits the allegations of this paragraph, except to note that (i) the dates of first use in the registration are "at least as early as" dates and that California may prove earlier dates, and (ii) California used the mark in earlier forms at still earlier dates.

30. California denies the allegations in this paragraph, except to note that the letters SC in California's registration no. 2,683,137 are in some ways similar to the letters SC in Carolina's pending application.

31. California denies the allegations of this paragraph.

32. California admits the allegations of this paragraph.

33. California admits the allegations of this paragraph describing the general allegations in this proceeding, and denies the allegation that Carolina possesses superior common-law rights to the SC mark.

34. California denies the allegations of this paragraph.

35. California denies the allegations of this paragraph.

Affirmative Defenses

I. Prior Registration (Morehouse) Defense

Under the prior registration (*Morehouse*) defense, Carolina cannot cancel California's registration no. 2,683,137. California owns an incontestable registration for the letters SC in typed form (registration no. 1,844,953, which is at issue in this proceeding). California acknowledges that the Board found that Carolina is not precluded as a matter of *law* from bringing its counterclaim, but California intends to prove that it is entitled to judgment in whole or in part based on the prior registration defense as a matter of *fact*.

II. Abandonment

To the extent that Carolina proves the existence of common-law rights based on its past use of the letters SC, California alleges, based on knowledge and belief, that Carolina has abandoned those rights.

III. Affirmative defenses based on delay

California asserts the defenses of laches, estoppel, and acquiescence. On information and belief, Carolina has had both actual and constructive knowledge about California's use and registration of its SC mark for many years, and has not heretofore objected to California's use or registration of SC. During that time, California has spent considerable money promoting and using its SC mark, and had developed incalculable goodwill in the mark. It would therefore be inequitable to cancel any California registration for SC at this late date.

IV. Other affirmative defenses

California notes that discovery is ongoing and therefore reserves the right to assert additional defenses such as unclean hands or fraud as warranted by the facts as they unfold.

Wherefore, California asks that the Board deny the counterclaim and grant any other relief it deems proper.

DATED: August 8, 2005

GIBSON, DUNN & CRUTCHER LLP

By: /pfw/
Peter F. Weinberg
1801 California St., Suite 4200
Denver, CO 80202
Phone: (303) 298-5901

Attorneys for University of Southern California

20184144_2.DOC

Certificate Of Service

I hereby certify that I am mailing a copy of the foregoing Answer to Counterclaim by United States Postal Service first class mail, postage prepaid, to John C. McElwaine, Nelson Mullins Riley & Scarborough, L.L.P., Liberty Building, Suite 500, 151 Meeting Street, Charleston, SC 29401 on the date written below my signature, and emailing a copy of the foregoing to jcm@nmrs.com.

/pfw/
Name: Peter F. Weinberg
Date: August 8, 2005